

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/871,367 05/31/01 KRIWET

K 4-30724A

001095  
THOMAS HOXIE  
NOVARTIS CORPORATION  
PATENT AND TRADEMARK DEPT  
564 MORRIS AVENUE  
SUMMIT NJ 07901-1027

HM12/0829

EXAMINER

KIM, V

ART UNIT	PAPER NUMBER
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1614

3

DATE MAILED: 08/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/871,367	KRIWET ET AL.
	Examiner Vickie Y. Kim	Art Unit 1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

Acknowledgement is made of preliminary amendment filed August 3, 2001. the claims 1-13 have been canceled. The claims 14-38 are presented for the examination.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 14-38, the word "means" is preceded by the word(s) "to retain water" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura et al(US 5,385,907) in view of Baumann et al (US 5352671).

Asakura et al teaches a topical ointment comprising a tricyclic compounds of ascomycin and FK-506 substances, or it's analogs, inorganic salts(see column 4, lines 58-65), carboxylic acid(e.g. oleic acid-column 6, lines 30-35), carboxylic acid esters(e.g.isopropyl myristate-column 5, lines 50-60), and hydrocarbon materials(e.g. wax, paraffin oil). This patented composition is made to enhance solubility, stability and penetration(absorption). Furthermore, Asakura teaches a method for treating immunologic-mediated diseases including inflammatory and hyperproliferative diseases; see column 1, lines 10-25. The All the claimed elements are taught by Asakura except the species required by claims 15 and its dependent claims .

However it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Asakura composition so as to include a further teaching as taught in Baumann because Baumann teaches both ascomycin and it' derivatives including 33-epi-chloro-33-desoxy-ascomycin wherein the physical and chemical properties are substitutable to the other.

One would have motivated to apply the patented enhancing system(Asakura's ointment base) to benefit other tricyclic compounds whose properties are similar, so that the pharmacological activities could be improved. Because the solubility, stability and absorbency plays major role in the successful topical treatment, they are considered as most critical elements.

Thus one would have been motivated to combine these references to make the modification to improve the quality , with reasonable expectation of success because they are drawn to same technical fields with same utility, and pertinent to the problem which applicant is concerning. MPEP 2141.01(a).

All the dependent claims are properly included in this rejection because all the limitations are encompassed by this modification.

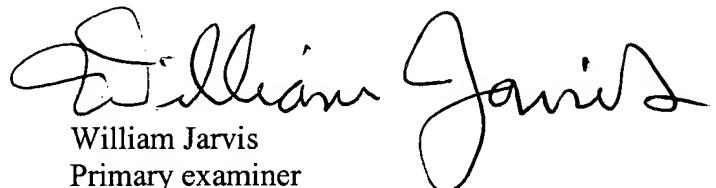
***Conclusion***

All the pending claims are rejected.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is (703) 305-1675 (Tuesday-Friday: 8AM-6:30PM) and Fax number is (703) 746-3165.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Vickie Kim,  
Patent examiner  
August 24, 2001

  
William Jarvis  
Primary examiner  
Art unit 1614